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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,102	07/09/2003	Hans Schmotzer	MEISS71.007DV1	1655

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TRK

Office Action Summary

Application No.

10/616,102

Applicant(s)

SCHMOTZER ET AL.

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/5/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitations of the “previously-determined distance” being between “about 26.4mm and about 37.44mm” or “about 32mm” or between “about 30.45mm and about 33.35mm” was not found in the written disclosure. The use of the terms “about” causes some ambiguity because it is not clear according to the disclosure how much of a deviation from the disclosed range the term “about” is suppose to be interpreted with respect to the Applicant’s distance of components.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13,14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation in claim 13 that the "previously-determined distance is between about 26.4mm and **about 37.44mm**" is not supported in the specification. The written disclosure on page 3, line 12 provides support for *up to 34mm*, but not beyond that. The limitation "about 26.4mm" could fall within the disclosed range of 24-34mm, but the limitation "about 37.44mm" could be interpreted as 40mm, which is well beyond the disclosed range of 34mm.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims are 1,2,5,6,16,18,19 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Antonio (5810831). Fig. 1 shows a slideway with two convexly curved condyles and inherently has a patella shield. Fig. 2 illustrates that the femur has two holes drilled for pegs located on the slideway. D'Antonio discloses that surgeons remove more bone from the dorsal side of the femur than replaced by the slideway, col. 1, lines 53-64. D'Antonio also discloses (col. 5, lines 40-42) using a template to size the femur and shows (Fig. 2) at least one bore 60 separated by a pre-determined distance. It is inherent that the surgeon is going to locate a point to drill a hole. It is also inherent that the slideway is fitted onto the femur and that pegs are inserted into the holes formed in the femur.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3,4,7,9-15,17,20,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831. D'Antonio is explained supra. However, D'Antonio fails to disclose the pre-determined distance between the condyles and a point located on the femur being "about" 5-15% larger than the dimension of the between the peg and prosthesis condyles. It would have been an obvious matter of design choice to modify the amount of slideway surface provided for articulation, since applicant has not disclosed that using a larger amount provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with distance provided in the preparation of the femur taught by D'Antonio or the claimed 10% in claim(s) 4,10,21 because both procedures perform the same function of taking into consideration the anatomy conditions of the patient and the articulation of the prosthesis with respect to the ligaments. With respect to claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a slideway having about 2-5% dimension of a distance between a dorsal sliding surface and a ventral sliding surface, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. Regarding claim 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to resect about

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10% more bone from the dorsal side of the femur, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. With respect to claims 11-15, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a distance between the peg and dorsal sliding surface of the slideway having a range between 24-34mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831 in view of Colleran et al. (5776201). D'Antonio is explained supra. However, D'Antonio fails to disclose providing a group of slideways with different dorsal condyle-to-ventral condyle distances. Colleran et al. teach (Fig. 4) a group of slideways is provided in a surgical procedure to prepare a femur for implanting a prosthesis. Colleran teaches the femoral prostheses are different sizes, col. 2, lines 54-56. It would have been obvious to one of ordinary skill in the art to use a plurality of femoral prostheses as taught by Colleran et al. in D'Antonio's method of surgery on a femur such that the surgeon has a proper fitting prosthesis for the patient since all patients are going to have different anatomical features.

Response to Arguments

Applicant's arguments filed 7/5/05 have been fully considered but they are not persuasive. The Examiner was not convinced about the claimed limitations unsupported

in the specification. Applicant argues that D'Antonio does not disclose locating a point at a "pre-determined distance from a plane tangent to the dorsal most points of the medial condyles of the femur and drilling a hole at that point. However, it must be noted that it is the Examiner's position that it is inherent that a point is located at a predetermined distance from a plane tangent to the dorsal most points of the medial condyles of the femur because the surgeon clearly is not just going to randomly drill a hole and then try to fit the prosthesis thereon. Applicant also argues that D'Antonio does not disclose removing more bone than is replaced by the slideway. As mentioned above D'Antonio suggests more bone can be removed, which would imply that more would be removed to fit within the slideway. Additionally Applicant mentions that D'Antonio does not teach a slideway with a peg or implanting the slideway with the peg in a drilled hole. It should be noted that a surgeon would not drill a hole in a patient's bone and not use it, thus it is inherent that the slideway includes a peg and the surgeon implants the peg in the hole.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 7am to 4:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

BRIAN E. PELLEGRINO
PRIMARY EXAMINER

Brian E Pellegrino